

REMARKS

Claims 1-32 are pending. New Claims 29-32 are added in this Response.

Claim 1-28 stand rejected under Section 102(e) as being anticipated by Miyamoto (6,456,391) or under Section 103 as being obvious over Miyamoto in view of other references Brogliatti (6,564,225).

Miyamoto And Brogliatti Are Not Prior Art.

The Rule 131 Declaration of Steven R. Ormiston submitted on behalf of Hewlett-Packard Development Company Ltd., the assignee, accompanies this Response. (The inventor is no longer employed by Hewlett-Packard Company.) The documents attached to Mr. Ormiston's Declaration show that the claimed subject matter was conceived and actually reduced to practice before the dates Miyamoto and Brogliatti were filed in the United States. The documents attached to Mr. Ormiston's Declaration also show that the claimed subject matter was conceived before the dates Miyamoto and Brogliatti were filed in the United States and thereafter a constructive reduction to practice was pursued with reasonable diligence. Miyamoto should, therefore, be withdrawn as a prior art reference.

1. Mapping The Claimed Subject Matter To The Invention Disclosure.

Claims 1 and 8 recite a printer user interface that includes a processor responsive to a user input to print a thumbnail of an image file in the same orientation in which the image file was acquired by utilizing stored orientation information. Claim 15 recites a method that includes printing a thumbnail of an image file in the same orientation in which the image file was acquired by utilizing stored orientation information. Claim 22 recites memory media comprising means for controlling a processor to print a thumbnail of an image file in the same orientation in which the image file was acquired by utilizing stored orientation information. Claim 29 recites a printer user interface that includes a processor responsive to a user input to print thumbnails of said images in an orientation designated by said source. Claim 31 recites memory media including instructions for a printer processor to print thumbnails of images received from a source external to the printer in an orientation designated by said external source.

The invention disclosure document attached as Exhibit 1 to the Ormiston Declaration describes one embodiment of this feature in Claims 1, 8, 15, 22, 29 and 31 at page 4, which states:

"Photos will print in the orientation (landscape vs. portrait) designated by the input source. Typically, this will be from a digital camera. Some cameras have sensors that automatically detect the orientation that the photo was taken in. Some cameras allow users to manually rotate the photos using the camera interface."

Claims 2 and 9 recite the processor further responsive to a user input to print an index page of thumbnails of a selected subset of a plurality of image files. Claim 16 recites the method further comprising printing an index page of thumbnails of a selected subset of a plurality of image files. Claim 23 recites that the memory media further comprises means for controlling the processor to print an index page of thumbnails of a selected subset of a plurality of image files. Claim 30 recites a printer user interface that includes a processor responsive to a user input to print an index page of thumbnails of a selected subset of images. Claim 32 recites memory media including instructions for a printer processor to print an index page of thumbnails of a selected subset of images received from a source external to the printer.

The invention disclosure document attached as Exhibit 1 to the Ormiston Declaration describes one embodiment of this feature in Claims 2, 9, 16, 23, 30 and 32 at page 4, which states:

"Users can choose which photos they want to include on the index page. They do this by pressing the CHOOSE PHOTOS button to display the desired photo, then press the OK button to enter it. They repeat these steps to choose additional photos."

The features recited in the other dependent claims (Claims 3-7, 10-14, 17-21 and 24-28) are also described on page 4 of the invention disclosure document attached as Exhibit 1 to the Ormiston Declaration.

2. *Actual Reduction to Practice.*

The invention disclosure document attached as Exhibit 1 to the Ormiston Declaration, which describes the claimed subject matter, was signed by the inventor on June 17, 1999. The invention disclosure document states on page 1 that as of June 17, 1999 the invention described therein had already been built and that usability test subjects were under a non-disclosure agreement.

3. *Constructive Reduction to Practice.*

The following chronology, which is documented in Exhibits 1-8 in the Ormiston Declaration, reflects the events occurring between the time the invention disclosure document was submitted by the inventor and the time the patent application was filed. There are two unusual events in this chronology -- the inventor's maternity leave and the death of outside counsel writing the patent application. While these events may be unexpected in this chronology, they cannot be deemed unreasonable.

June 17, 1999 -- The invention is documented in an Invention Disclosure No. 10991850 submitted to HP's legal patent department.

July 27, 1999 -- The Invention Disclosure is reviewed by an HP patent review committee. The Invention Disclosure is approved for filing a patent application pending the results of a patentability search.

October 12, 1999 -- David Koffsky, outside counsel assigned to conduct the patentability search and prepare the patent application, advised inventor Wendy Hunter of the search results.

October 20, 1999 -- Inventor Wendy Hunter sends additional materials to outside counsel as requested.

February through June 2000 -- preparation and review of draft patent applications delayed because inventor Wendy Hunter is on maternity leave and outside counsel David Koffsky dies unexpectedly.

July 12, 2000 -- Final draft patent application is completed and outside counsel requests inventor information for Declaration and Assignment.

August 22, 2000 -- Declaration and Assignment submitted by outside counsel to HP for inventor signature.

September 22, 2000 -- patent application is filed.

Miyamoto Does Not Anticipate Claims 1-4, 7-11, 14-18, 21-25 and 28.

With regard to Claim 1, the Examiner cites to item 22 in Fig. 2 and col. 3, lines 20-27 in Miyamoto as teaching printing a thumbnail image in the same orientation in which the image was acquired utilizing stored orientation information. This assertion is not correct. There is nothing about printer 22 in Fig. 2 or the text at col. 3, lines 20-27 that teaches or suggests anything about the orientation of the thumbnail images. Fig. 4 in Miyamoto shows thumbnail images all printed in

landscape orientation. Other than that, Miyamoto does not say or show anything about the orientation in which the thumbnail images are printed. The most that can be said of the teachings of Miyamoto about thumbnail image print orientation is that all thumbnail images are printed in landscape orientation without regard to the orientation in which those images were acquired.

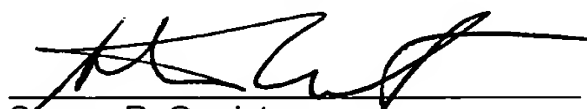
With regard to Claim 2, the Examiner states only that "it is analogous variation of what is in fact discussed above in claim 1, thus, argument presented above for claim 1 is not repeated herein, but is incorporated by reference." Claim 2 depends from Claim 1 and adds the limitation that the processor is further responsive to a second user input to print an index page of thumbnails of a selected subset of said plurality of image files. The Examiner comments in no way address this additional limitation. In fact, Miyamoto does not teach or suggest this additional limitation.

The same analysis applies to Claims 8-9, 15-16 and 22-23. For these reasons, Claims 1-2, 8-9, 15-16 and 22-23 distinguish patentably over Miyamoto. Claims 3-4, 10-11, 17-18 and 24-25 also distinguish over Miyamoto at least due to their dependence on Claims 1, 8, 15 and 22, respectively.

Formal Drawings

Formal drawings accompany this Response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "S. Ormiston", written over a horizontal line.

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